

REMARKS

In the Office Action dated March 11, 2003, claims 1-54 were presented for examination. Claims 1-15 and 43-49 were objected to based upon a supposed informality. Claims 1-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Lathan et al.* in view of *Sheaffer et al.*

Applicants wish to thank the Examiner for the careful and thorough review and action on the merits in this application.

I. Information Disclosure Statement

Applicants submitted an Information Disclosure Statement in conjunction with the Request for Continued Examination on January 26, 2004. In view of the fact that the PTO Form 1449 was not acknowledged by the Examiner, attached please find a copy of the PTO Form 1449 that was filed with the Information Disclosure Statement. Applicants respectfully request the Examiner to acknowledge receipt of the PTO Form 1449 in the next communication.

II. Claims

The Examiner has objected to claims 1-15 and 43-52 because the phrase "adapted to" is present therein. However, the Examiner has not provided a legal precedent, statutory basis, or legislative basis for the objection and requirement of removal of such language from the claims. Accordingly, Applicants respectfully request that the Examiner either remove the objection to the claims or to provide legal support for the objection in the next Office Communication.

III. Inventorship Information

Pursuant to a telephone conference with Examiner held on June 14, 2004, the Examiner indicated that a response to this issue is not required at this time. The Applicant hereby reserves the right to respond to this issue at such time as a response is requested by the Examiner.

IV. 35 U.S.C. §103(a) - Obviousness over *Lathan et al.* in view of *Sheaffer et al.*

In the Office Action of March 11, 2004, the Examiner assigned to the application rejected claims 1-55 under 35 U.S.C. §103(a) as being unpatentable over *Lathan et al.*, U.S. Patent No.

6,511,442, in view of *Sheaffer et al.*, U.S. Patent No. 6,084,205.

The *Lathan et al.* patent relates to an evaluation and training system primarily using EMG sensors. The system includes feedback means to manipulate the environment outside of the immediate surroundings of the user.

The *Sheaffer et al.* patent relates to a welding process. More specifically, *Sheaffer et al.* measures radiation emitted to a specified site to determine weld penetration. Data received from the radiation measurement in conjunction with dynamic feedback determine welding current to be supplied to a welder torch.

In reviewing and studying the prior art references of *Lathan et al.* and *Sheaffer et al.*, it is clear that the scope of these two prior patents and Applicant's claimed invention are divergent in nature. The *Lathan et al.* patent accounts for an evaluation and training system primarily using EMG sensors with feedback means to manipulate the environment outside of the immediate surroundings of the user. The *Sheaffer et al.* patent accounts for a control system associated with a welding apparatus. Neither *Lathan et al.* nor *Sheaffer et al.* provide support for biometric sensors in combination with a dynamic feedback control system to sense biological phenomena, and to transmit motion associated therewith to an actuator of a robotic apparatus. Applicants are using biometric sensors to sense biological phenomena and to transmit motion associated therewith to an actuator of a robotic apparatus. The robotic apparatus, as claimed by Applicants, provides a dynamic feedback control system between a biological sensor and a robotic actuator. The sensor of Applicants is used in conjunction with a dynamic feedback control system to promote wireless communication with a robotic actuator. Accordingly, Applicant's invention and *Lathan et al.* clearly diverge with respect to sensor type and feedback of sensor data.

As the CAFC has made clear, the prior art must teach the desirability of the modification. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is axiomatic that the subject matter of the claims may not be considered obvious as a result of a hypothetical combination of references

unless something in the references suggests that an advantage may be derived from combining their teachings. In this respect, the CAFC appears to speak directly to the issue of the need to determine the scope and contents of the prior art, and the source of motivation for combining the references. Accordingly, the determination as to what may be within the scope and contents of the prior art serves to establish the parameters of what art may even be considered in determining the obviousness of an invention.

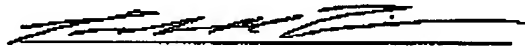
The Examiner utilizes *Sheaffer et al.* to teach the limitations associated with Applicant's dynamic feedback control system. However, as stated above, *Sheaffer et al.* is limited by its use to welding process. In this way, *Sheaffer et al.* fails to account for Applicant's use of a dynamic feedback control system in association with a biometric sensor and a robotic actuator. In fact, both *Lathan et al.* and *Sheaffer et al.* fail to address Applicant's use of a dynamic feedback control system in association with a biometric sensor and a robotic actuator. "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' " MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d 1430 (Fed. Cir. 1990)). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). In fact, both *Lathan et al.* and *Sheaffer et al.* teach away from the modification suggested by the Examiner. *Lathan et al.* does not suggest modifying the system to include a dynamic feedback control system. Furthermore, there is no suggestion found in *Sheaffer et al.* for a modification to apply the dynamic feedback control system to a biometric sensor in communication with a robotic actuator. The only suggestion for a system that utilizes a dynamic feedback control system applied to a biometric sensor in communication with a robotic actuator is derived from Applicant's invention. Absent Applicant's invention, there is no suggestion or motivation within the combination of *Lathan et al.* and *Sheaffer et al.* for such a modification. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has attempted to undertake. The combination of the prior art references is improper as the Examiner's combination is

precipitated by utilizing Applicant's claimed invention as the template to make the modifications suggested by the Examiner. Accordingly, the Applicants respectfully submits that claims 1-54 would not have been obvious in view of *Lathan et al.* ('442) in view of *Sheaffer et al.* ('205) and respectfully requests removal of the rejection.

In light of the foregoing amendments and remarks, all of the claims now presented are in condition for allowance, and Applicants respectfully request that the outstanding rejections be withdrawn and this application be passed to issue.

The Examiner is urged to call the undersigned at the number listed below if, in the Examiner's opinion, such a phone conference would aid in furthering the prosecution of this application.

Respectfully submitted,



Rochelle Lieberman
Registration No. 39,276
Attorney for Applicants

Lieberman & Brandsdorfer, LLC
12221 McDonald Chapel Drive
Gaithersburg, MD 20878
Phone: (301) 948-7775
Fax: (301) 948-7774
email: rocky@legalplanner.com

Date: June 14, 2004

The transmission ends with this page